

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ORNA LEVIN and DAVID MARCOS

Appeal No. 1999-1321
Application No. 08/625,495

ON BRIEF

Before ROBINSON, MILLS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 -5, 7, 9, 14, 17, and 18. Claim 1 is representative and reads as follows:

1. A pharmaceutical or veterinary composition comprising:
 - (a) at least one volatile oil, selected from the group consisting of anise oil, calendula oil, quassia oil, rosemary oil and sassafras oil, said oil being present at a concentration in a range of from about 5% to about 50% volume per volume;

(b) at least one alcohol being present at a concentration in a range of from about 20% to about 60% volume per volume; and

(c) at least one ingredient selected from the group consisting of fixed oil and emollient ester of fatty acid derived from vegetable oils, said at least one ingredient being present at a concentration in a range of from about 10% to about 60% volume per volume.

The examiner relies on the following references:

Stoltz	5,455,055	Oct. 3, 1995
United Kingdom Patent Application		
Melnicake	1 574 609	Jul. 6, 1976
Joanides	2 228 411	Aug. 29, 1990

Claims 1-5, 7, 9, 14, 17, and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as not supported by an adequate written description.

Claims 1-5, 7, 9, 14, 17, and 18 also stand rejected under 35 U.S.C. § 103 as obvious over Stoltz, Joanides, and Melnicake.

We reverse both rejections.

Background

The claims are directed to a composition comprising a “volatile oil,” an alcohol, and a “fixed oil [or] emollient ester of fatty acid derived from vegetable oils.” The specification discloses that volatile oils have been used as a treatment for lice (page 2, lines 4-5). However, volatile oils are rather expensive and pure volatile oils tend to cause a burning sensation and erythema when they are applied to skin. Page 2, line 21 to page 3, line 2. Diluting the volatile oil with fixed oil reduces both the side-effects and the potency, while diluting the volatile oil with alcohol retains the potency but also the side-effects. Page 3, lines 2-9.

The specification discloses that the claimed compositions have insecticidal activity against lice but do not cause burning or reddening of the skin. See pages 5-9.

Discussion

1. The written description rejection

The examiner rejected all of the claims as unsupported by an adequate written description. The examiner states that “[w]hile specific ranges of ingredients are recited at page 6 and other ranges are exemplified in the tables and examples, basis for the broadening of these recitations to encompass ‘about’ these amounts is not found in the as filed specification. . . . There is no indication in the as filed specification tha[t] Appellants intended the stated ranges to be approximate and to what extent.” Examiner’s Answer, page 4.

The examiner’s position, as we understand it, is that the specification supports the percentage ranges recited in the claims, but does not support adding the modifier “about” to the endpoints of the ranges. We decline to apply the written description requirement so strictly.

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in haec verba support for the claimed subject matter at issue.” Purdue Pharma L.P. v. Faulding, Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). Nonetheless, the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. See id. “It is not necessary that the

application describe the claim limitations exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure that appellants invented processes including those limitations.” In re Herschler, 591 F.2d 693, 700, 200 USPQ 711, 717 (CCPA 1979).

The instant specification describes the inventive compositions broadly, as compositions comprising a volatile oil, an alcohol, and a fixed oil, without reciting specific amounts of each ingredient. See page 5, line 19 to page 6, line 3. Original claim 1 also set no limit on the proportion of volatile oil, alcohol, and fixed oil in the claimed compositions. It is true that the specification recites ranges of ingredients without including the modifier “about.” Page 6, lines 16-22. When we view the recited ranges in context, however, we find that one having ordinary skill in the art would recognize that Appellants invented the compositions now claimed. Therefore, the specification provides an adequate description of the claimed compositions.

2. The obviousness rejection

The examiner rejected the claimed compositions as obvious over the combined disclosures of Stoltz, Joanides, and Melnicake. Stoltz discloses cooking sprays comprising vegetable oil, ethanol, and other components including flavoring agents. The examiner points specifically to an herbal salad dressing spray disclosed by Stoltz, which comprises vegetable oil (74.9% to

94.4%¹), ethanol (3% to 10%), and an herbal concentrate that could be rosemary oil (2.5 to 15%). See column 9, lines 35-54. Joanides discloses cosmetic compositions comprising egg whites, citrus fruit extract, vegetable oil (15% to 45%), ethanol (5% to 15% of distilled spirits), and “up to 1% . . . rosemary essential oil.” Page 3, line 4 to page 4, line 8. Melnicake discloses insecticidal compositions comprising pyrethrum, a known insecticide. Melnicake teaches that combining pyrethroids with “oil of pepper” synergistically improves their insecticidal activity. Page 1, lines 90-95. Melnicake discloses that the composition can also contain quassia (page 2, lines 122-125), “other essential oils,” (page 3, lines 1-4), and “polyhydric alcohols e.g. propylene glycol and triethylene glycol” (page 3, lines 10-12).

The examiner concluded that a person of ordinary skill in the art would have been motivated to combine the teachings of these references to produce the claimed compositions “because of the known beneficial properties of the combination of volatile oil, fixed oil and alcohol as demonstrated by the references in a variety of pharmaceutical or veterinary applications and because of their known properties to kill and/or repel insect pests.” Examiner’s Answer, page 6.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of going forward with evidence or argument shift to the

¹ Stoltz’s percentages are “% by weight,” see col. 9, line 40, while the claimed compositions are

applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Prima facie obviousness based on a combination of references requires that the prior art provide “a reason, suggestion, or motivation to lead an inventor to combine those references.” Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

In this case, the examiner has not established that a person skilled in the art would have been motivated to combine the cited references. Stoltz discloses a salad dressing spray, while Joanides discloses a cosmetic composition for removing wrinkles. Neither Stoltz nor Joanides discloses any insect repellant or insecticidal activity of their respective compositions. Although the examiner states that “[t]hese compositions would reasonably be expected to constitute natural insect repellants,” Examiner’s Answer, page 4, she provides no evidence or scientific reasoning to support this assertion.

Melnicake discloses an insecticidal composition, but nowhere discloses that the composition is suitable for application to skin or hair. The closest Melnicake comes to suggesting a veterinary or pharmaceutical application of his compositions is to suggest that they can be applied to plants (page 3, lines 27-31).

The examiner has not adequately explained why a person of skill in the art would have been motivated to combine the components of these seemingly disparate compositions, so as to produce a composition as now claimed. The

defined in “volume per volume” percentages. The examiner’s rejection does not address this

examiner has not shown, for example, that those skilled in the art would have thought it a good idea to combine an insecticide with either a salad dressing or a cosmetic. Nor has the examiner established any other basis for the skilled artisan to combine the teachings of the cited references (except, of course, to meet the limitations of the instant claims).

Where the prior art does not provide motivation to combine the teachings of the cited references, rejection for obviousness is improper. We reverse the rejection under 35 U.S.C. § 103.

Other Issues

Independent claim 14 is directed to a composition comprising, among other things, “at least one volatile oil selected from the group consisting of anise oil, calendula oil, quassia oil and sassafras oil.” Claim 2 depends on claim 14 and states that the “volatile oil is selected from the group consisting of anise oil, calendula oil, quassia oil, rosemary oil and sassafras oil” (emphasis added). Claim 2 does not seem to comply with 35 U.S.C. § 112, fourth paragraph, which states that “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed” (emphasis added). After return of this case, the examiner should ensure that all the dependent claims comply with 35 U.S.C. § 112, fourth paragraph.

discrepancy.

Summary

We reverse the written description rejection because the specification adequately shows that Appellants invented the claimed compositions. We reverse the § 103 rejection because the prior art does not provide adequate motivation to combine the cited references.

REVERSED

DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
DEMETRA J.MILLS)	
Administrative Patent Judge)	APPEALS AND
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